

if the new claims and amendment present any issues that could delay issuance, the Examiner is respectfully requested to contact the undersigned by telephone at the number provided below.

The Decision reverses the rejection of the claims and remands the case to the Examiner to consider whether certain claims would be obvious in view of additional patents. In response, the Examiner is requested to more particularly consider the following regarding the patents listed in the remand.

A. It is not prior art.

The bulk of the patents cited by the Board are not prior art. Compare the filing date and effective (priority) dates for the instant patent application with the filing dates of the referenced patents.

The present case was filed on February 18, 1997, prior to the filing dates for the following patent's cited in the Board's Decision:

Des. 431,879,

D449,879, and

D449,777.

These cannot be prior art because they are filed after Applicant's filing date in the instant patent application.

Further, the instant patent application has an earlier effective filing date by claiming priority from the parent filed November 15, 1994, and support for the broadest claims in the instant patent application is disclosed in the parent.

Attention is drawn to Figure 4 (or 5) in connection with Applicant's parent (Now U.S. Patent No. 5,695,055 enclosed for the Examiner's convenience.) Applicant's patent at Col. 4, lines 14-17 states:

...an embodiment of the present invention can be located in the thematic packaging 52 that resembles a golf ball.

See also Col. 4, lines 31-34:

In a similar vein the items in the box 54 can include ...a rain coat or vest, a hat, a wiping cloth, or a seat cover....

See also Col. 4, lines 40-44:

Similarly thematic packaging can be used to market ...these include gear housed in packaging shaped like baseballs, footballs, tennis balls, etc. for use at such sporting events...

Compare with the claims herein to see that priority extends back to the filing date of the parent case. Accordingly, the following also are not prior art:

D373,245,

D394,156,

D424,295,

D388,606,

D392,096, and

D390,103.

These cannot be prior art because they are filed after Applicant's effective (priority) filing date for the instant patent application.

In sum, these are not prior art.

B. It is not, in the words of the Decision, "associated with...."

The Decision at pages 4-6 reversed the Examiner's rejection based on Agapiou for not meeting the associated with claim requirement: "the examiner has not persuaded us that *an artisan would associate educating pedestrians about safety awareness with Agapiou's container in the shape of a flat tire.*" (Italics added.)

Des. 194, 287 ("Proietti") is a tire-shaped storage container for automotive

cleaning accessories and the like. Applying the Board's Decision to Proietti, an artisan would not associate the activity of cleaning with Proietti's container in the shape of a tire. Compare this with the Board's example of claim scope as "an activity 'associated with' the golf ball replica package would be playing the game of golf, and the article contained within the package, namely a golf tee, is used in playing the game of golf." See Decision at pages 3-4. In Proietti, while the cleaning supplies inside the package can be used in the activity of cleaning a car, in no way does the shape of the tire container convey the activity of cleaning. In Proietti, one would not know about cleaning without opening the container to discover that the contents are cleaning supplies. But in contrast, in claim 5, for example, the shape of the package (golf ball, in the example discussed in the Decision at pages 3-4) is associated with playing or watching golf, wherein the contents are used. Thus, Proietti does not teach or suggest the following Claim 5 requirement: ...the shape of the package visually conveying information about an activity associated with the icon in which the article is used.

The same applies to Des. 217,412 ("Moquin"), a tire-shaped carrying case for toy cars. In no way is the tire shape "associated" with the activity of playing, nor does it convey information about playing. No one would conceivably think of playing with toy cars merely by looking at the tire case and no one would infer it contained toys unless they opened the case and discovered the toy cars therein. Moquin suffers from the same problem as Agapiou, that there is no teaching or suggestion of the following claimed requirement: ...the shape of the package visually conveying information about an activity associated with the icon in which the article is used.

In sum, these all fail to disclose or suggest a claim requirement or the invention as a whole, and thus these do not show obviousness.

C. **It is not, in the words of the Decision, "does not disclose or suggest any of the shapes called for"**

The Decision reversed the Sec. 103 rejection because the cited art "does not disclose or suggest any of the shapes called for" Similarly, none of the newly cited art that is properly characterized as PRIOR ART is directed to "the shapes called for..." in the claims. For example, most certainly no cited art discloses or suggests putting rain gear in a plastic golf ball, as required in claim 25.

D262,189 ("Swatek") shows a Band Aid shape for a "container for first aid items or the like." However, Swatek does not teach the claim 5 requirement of a shape that is different than any shape to be contained therein, i.e., Swatek does not teach NOT putting a regular-shaped Band Aid in the Band Aid-shaped container.

The same applies to D57,436, wherein the saw-shaped "tool chest" does not teach preclusion of a saw shape from among the tools.

The same applies to Des. 217,412 ("Moquin"), wherein the tire-shaped holder does not teach preclusion of a tire shape within the contents of the case.

As to D346,185, football cards have been produced with the same shape as the container, as illustrated in the enclosed. There is no showing of the claimed a shape that is different than any shape to be contained therein. Football cards have been made in the shape of a flattened football, as illustrated in the enclosed. D346,185 does not teach preclusion of any shape to be contained in the package.

D. Miscellaneous

The cited art does not show discovery of the problem being solved in the instant patent application, and with no discovery of the problem, it's solution make's no sense via attempted extension from the prior art the to Applicant's claims. See, e.g., *In re Peehs*; *In re*

Nomiya; In re Sponnoble; Eibel Process v. Minnesota & Ontario Paper.

Further, design patents on containers per se do not teach the claimed combination because as a trip to any Container Store would show, containers in a countless variety of shapes for a countless variety of items are marketed separate from contents all the time. Most importantly, the claimed teaching of the following Claim 5 requirement: the shape of the package visually conveying information about an activity associated with the icon in which the article is used. There is nothing in the record that teaches this as prior art, and consistent with the Decision, the newly cited art that qualifies as PRIOR ART does not meet this claim limitation either.

The new claims revisions attend to Sec. 112 problems and add new claims along the lines of those claims considered by the Board in reversing the rejection, e.g., essentially repeating claim 5 directed to the sports activity or otherwise based on the invention considered on appeal, multiple golf balls in a sleeve, different contents in the packages, etc. as in previously presented claims.

E. Summary

The Board Decision reversed the rejection, but remanded for consideration of additional art. However, the bulk of this new art does not even qualify as PRIOR ART. Of the art that even qualifies for consideration, none disclose structural limitations set out above (e.g., putting rain gear in golf ball replica packaging) or even a discovery of the problem sought to be solved by the present invention. Accordingly, consistent with the Decision, the claims have not been shown unpatentable.

III. CONCLUSION

The application, as amended, is believed to be in condition for allowance, and favorable action is requested. Again, in view of the Decision reversing the rejection and the

delay in issuance of this application in view of the appeal, if the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

Respectfully submitted,

Date:

October 21, 2002



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I hereby certify that this correspondence is being filed via facsimile with a confirmation copy deposited with the United States Postal Service as first class mail in an envelope with sufficient postage and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on the date indicated below.

Date: October 21, 2002

Signed: Peter K. Trzyna (Reg. No. 32,601)

PATENT

Paper No.

File: Kor1-CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : Charles Kormanik, Jr.
Serial No. : 08/802,472
Filed : February 18, 1997
For : THERMATIC PACKAGING SYSTEM
Group Art Unit : 3208
Examiner : Luby, M.

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

AMENDED VERSION OF THE CLAIMS

SIR:

Set forth below is the amended version of the claims.

5.(Six Times Amended) A method for making a combination of a thematic package and an article contained in the package, the method including the steps of:
constructing the package as a replica of a recognizable icon, the package having a shape that is different than any shape [of the article] to be contained therein,
the shape of the package visually conveying information about an activity associated with the icon in which the article is used, and,
the package having a hallow interior; and

locating the article within the hallow interior of the package to form [a] the combination of the article and the thematically-shaped package.

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235. Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



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